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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,954	10/02/2000	Sunil K. Rao	IPHLNZ00202	3145
40518	7590	05/28/2010	EXAMINER	
LEVINE BAGADE HAN LLP 2400 GENG ROAD, SUITE 120 PALO ALTO, CA 94303			FADOK, MARK A	
		ART UNIT	PAPER NUMBER	
		3625		
		MAIL DATE		DELIVERY MODE
		05/28/2010		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/677,954	RAO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MARK FADOK	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 04 February 2010.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 48-51 and 53 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 48-51 and 53 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/4/2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 48-51 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz et al (US 6,587,835) and further in view of Trotta, Jr. (US 5,595,264).**

In regards to claims 48-51, Treyz teaches all the features of the instant claims except as follows:

Treyz teaches using a scanner to scan products and purchase them utilizing the barcode information provided from the scanner transmitted to the central computer (FIG

4,17,21,27,72,118, abstract and summary). Treyz teaches executing a transaction in response to a received transaction request, including communicating with at least one server received from the mobile device and comprising automatic payment using the bar code reader device (Treyz FIG 28, 60 (item 626 and FIG 110), but does not specifically mention automatically entering an item in an inventory database as sold, enabling the item to be removed from a store. Trotta, Jr., teaches automatically entering an item in an inventory database as sold, enabling the item to be removed from a store (FIG 2). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Treyz automatically entering an item in an inventory database as sold, enabling the item to be removed from a store, because this will eliminate the lengthy and sometimes objectionable checkout queues in which the customer must wait, thus saving time for the customer (Trotta col 2, lines 35-40).

Further, it is noted that all of the elements of the cited references perform the same function when combined as they do in the prior art . Thus such a combination would have yielded predictable results (see Sakraida, 425 US at 282, 189 USPQ at 453. Since the independent claims only unite old elements with no change in there respective functions the claimed subject matter would have been obvious under KSR, 127 S. Ct at 1741, 82 USPQ2d at 1396.

Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board

decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Wherein the transaction execution request can be transmitted from a remote position and local position relative to the store (Treyz, FIG 10).

**In regards to claim 53,** The combination of Treyz and Trotta Jr. teach wherein the automatic payment includes payment directly charged to an account maintained by the user with a service provider or payment by debiting an amount from an account maintained by the user within the mobile device (Treyz, FIG 28, 60 (item 626), and FIG 110).

#### ***Response to Arguments***

Applicant's arguments with respect to claim 48-51 and 53 have been considered but are moot in view of the new ground(s) of rejection. Further in regards to the statement in the previous office action that neither Gershman nor Treyz teaches any of the features found in the executing of a transaction request, the examiner has amended the previous rejection to state that Treyz does teach a transaction capability to make a purchase including receiving information from a remote mobile devise and processing the transaction using stored user purchase information and that the request may be made from any location including in store or from a remote position. Trotta in this case is used to address the feature of automatically entering data that has been scanned

and using that information to process an order automatically including making an adjustment to the inventory of the product.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300** [Official communications; including  
After Final communications labeled  
"Box AF"]

For general questions the receptionist can be reached at  
**571.272.3600**

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/  
Primary Examiner, Art Unit 3625